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In re Application of :
SABANATHAN, Thirumani :
Application No.: 09/762,692 :
PCT No.: PCT/GB98/00652 :
Int. Filing Date: 03 March 1998 :
Priority Date: 30 April 1997 :
Attorney Docket No.: 007-001 :
For: OCCLUSION DEVICE :

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on applicant's "RENEWED PETITION UNDER CFR 1.137(b) AND PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136" filed in the Patent and Trademark Office (PTO) on 24 September 2001.

BACKGROUND

The procedural background for this application was set forth in detail in the decision mailed by this Office on 24 May 2001. That decision dismissed applicants' petition under 37 CFR 1.137(b) because the delay was not considered to be unintentional.

On 24 September 2001, applicants responded to the 24 May 2001 decision by filing the "Renewed Petition under CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after applicant becomes aware of the abandonment and must be accompanied by: (1) the required reply, unless previously filed, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional and (4) a terminal disclaimer (for applications filed before 8 June 1995).

Applicant has satisfied items (1) and (2), as to item (4), since the application was filed after 08 June 1996, a terminal disclaimer is not required.

With regards to item (3) above, a review of the present renewed petition reveals that applicant has not provided the necessary evidence that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was

unintentional. In the Petition to Revive dated 09 February 2001, Mark Lunt declared that, "[d]ue to my mistaken belief that the (Bradford Hospitals NHS Trust) Trust owned all patent rights, I followed the instructions by the Trust not to file a U.S. National Phase Application." Mr. Lunt's statement was construed as being a deliberately course of action to not persist in seeking the revival of the abandoned application.

Petitioner asserts in the renewed Petition to Revive filed 24 September 2001 that, "[i]n the present case ... no decision to abandon was made by Applicant or any authorized agent of the Applicant. Mr. Lunt abandoned the application, acting on behalf of Bradford, contrary to the known desire of Applicant to prosecute the application, without any consultation with Applicant."

As stated in Manual of Patent Examining Procedure, 711.03(c)(E):

... where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See Winkler, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See Futures Technology Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

However, the papers show that Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute the above identified application. Additionally, Thirmunani Sabanathan states in her declaration that "if I cooperated with any patent application, then Bradford would pay for prosecuting the PCT Application, including Mr. Lunts' fee, and in the event the invention was commercialized and that I would share royalties equally with Bradford." Therefore, Mr. Lunt had authority to prosecute (or not prosecute) the application and Ms. Sabanathan is bound by the actions of Mr. Lunt.

Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(b), revival at this time would not be proper.

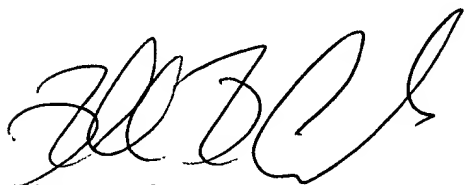
CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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